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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,864

03/11/2004

Evan Pennell

00216-661001 / Case 8131

6604

26161 7590 01/05/2007  
FISH & RICHARDSON PC  
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EXAMINER

CHOI, STEPHEN

ART UNIT

PAPER NUMBER

3724

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

01/05/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

JP

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/798,864		PENNEL ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Stephen Choi		3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935-C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 and 12-34 is/are pending in the application.
- 4a) Of the above claim(s) 2, 4, 6, 14-23, 25, 26 and 34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5, 7, 8, 12, 13, 24 and 27-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/3/06</u>   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3, 5, 12-13, 24, 27-29, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc (US 6,276,061).

Rozenkranc discloses the invention substantially as claimed including a housing having a primary guard (e.g., at 6) and a primary cap (e.g., at 5), one or more primary shaving blades (e.g., 3), a rear wall having a rear exterior surface extending along substantially the entire length of the trimming blade and defining a trimming cap (e.g., Figure 3a, unlabeled), a trimming blade having a trimming cutting edge (e.g., 4), and a trimming guard (e.g., Figure 3a, unlabeled). Rozenkranc fails to disclose an assembly mountable on the housing wherein the assembly comprising a blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of ordinary skill in the art to provide a separate assembly including a blade carrier made of sheet metal instead of an integral structure made of the same material because applicant has not disclosed the separate assembly including the blade carrier made of sheet metal provides an advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Rozenkranc's arrangement and applicant's invention, to perform equally well with either arrangement

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since both arrangements would have performed the same function. Applicants also disclose (paragraph 8) the assembly integrally formed of the same material as the housing as an alternative structure. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In *re Leshin*, 125 USPQ 416. Regarding claim 24, the modified device of Rozenkranc teaches alignment surfaces (e.g., surfaces on an unlabeled blade holder at 4). Regarding claims 27-28, the modified device of Rozenkranc teaches a shaving aid strip (e.g., 5). Regarding claims 32-33, e.g., Figure 1 of Rozenkranc.

3. Claims 1, 3, 5, 12-13, 24, 27-30, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown, Jr. (US 2004/0055156).

Brown discloses the invention substantially as claimed including a housing having a primary guard (e.g. 26), a primary cap (e.g. 29), and one or more primary shaving blades (e.g. 7-9), a blade carrier (e.g., at 4) defining a rear wall having a rear exterior surface extending downward to a terminating surface and extending along substantially the entire length of a trimming blade (e.g., see Fig. 2, 36) and defining a trimming cap (e.g., 34). Brown fails to disclose the blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of ordinary skill in the art to provide the blade carrier made of sheet metal because applicant has not disclosed the blade carrier made of sheet metal provides an

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advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Brown's arrangement and applicant's invention, to perform equally well with either arrangement since both arrangements would have performed the same function. It has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. Regarding claim 5, the modified device of Brown teaches a trimming guard (e.g., 33). Regarding claims 27-28, the modified device of Brown teaches a strip (e.g., paragraph 24). Regarding claim 30, e.g., see paragraph 20 of Brown.

4. Claims 1, 3, 5, 7-8, 12-13, 24, and 27-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rozenkranc in view of Applicant's Admitted Prior Art (hereafter AAPA).

In alternative, if it is argued that Rozenkranc does not teach the rear exterior surface extending along substantially the entire length of the trimming blade, Rozenkranc discloses the invention substantially as claimed including a housing having a primary guard (e.g., at 6) and a primary cap (e.g., at 5), one or more primary shaving blades (e.g., 3), a rear wall having a rear exterior surface and defining a trimming cap (e.g., Figure 3a, unlabeled), a trimming blade having a trimming cutting edge (e.g., 4), and a trimming guard (e.g., Figure 3a, unlabeled). Rozenkranc fails to disclose an assembly mountable on the housing wherein the assembly comprising a blade carrier formed from sheet metal. However, it would have been obvious matter of design choice to a person of ordinary skill in the art to

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provide a separate assembly including a blade carrier made of sheet metal instead of an integral structure made of the same material because applicant has not disclosed the separate assembly including the blade carrier made of sheet metal provides an advantage, is used for particular purpose, or solves a stated problem. One of ordinary skill in the art would have expected Rozenkranc's arrangement and applicant's invention, to perform equally well with either arrangement since both arrangements would have performed the same function. Applicants also disclose (paragraph 8) the assembly integrally formed of the same material as the housing as an alternative structure. Furthermore, it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179 and it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. Moreover, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the rear exterior surface extending along substantially the entire length of the trimming blade on the device of Rozenkranc since providing a rear exterior surface extending along substantially the entire length of a blade or blades as old and well known in the art for the purpose of providing a blade supporting body as admitted by the applicant. *Apprille, Carson, and Metcalf* show examples of a commercially available multi-blade shaving apparatus with a rear exterior surface extending along substantially the entire length of blades. It is noted that the common knowledge or well-known in the art statement of the previous

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office action has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. See MPEP § 2144.03. Regarding claims 7-8, the modified device of Rozenkranc discloses the invention substantially as claimed except for one or more skin protection structures between the trimming guard and the trimming cutting edge. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ one or more skin protection structures between the trimming guard and the trimming cutting edge as taught by AAPA on the modified device of Rozenkranc in order to protect the user's skin. Regarding claims 30-31, the modified device of Rozenkranc fails to disclose four or more primary shaving blades or five or more primary shaving blades. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ four or five or more primary blades as taught by AAPA on the modified device of Rozenkranc in order to enhance shaving action. It is noted that the common knowledge or well-known in the art statement of the previous office action of August 12, 2005 has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of Official Notice or that the traverse was inadequate. See MPEP § 2144.03.

5. Claims 7-8 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brown in view of AAPA.

Regarding claims 7-8, the modified device of Brown discloses the invention substantially as claimed except for one or more skin protection structures between the

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trimming guard and the trimming cutting edge. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ one or more skin protection structures between the trimming guard and the trimming cutting edge as taught by AAPA on the modified device of Brown in order to protect the user's skin. Regarding claim 31, the modified device of Brown fails to disclose five or more primary shaving blades. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ five or more primary blades as taught by AAPA on the modified device of Brown in order to enhance shaving action. It is noted that the common knowledge or well-known in the art statement of the previous office action of August 12, 2005 has been taken to be admitted prior art because applicant either failed to traverse the examiner's assertion of official notice or that the traverse was inadequate. See MPEP § 2144.03.

### ***Response to Arguments***

6. Applicant's arguments regarding Official Notice, filed October 5, 2006, with respect to the rejection(s) of claim(s) 10-11 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. Accordingly, this action is made Non-Final.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Choi whose telephone number is 571-272-4504. The examiner can normally be reached on Monday-Thursday 9:00-5:30.




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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer D. Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

sc  
22 December 2006

  
**STEPHEN CHOI**  
**PRIMARY EXAMINER**